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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,143	03/11/2004	Lutz Biedermann	B884:56717	7913
23363	7590	10/20/2006		EXAMINER
CHRISTIE, PARKER & HALE, LLP				HOFFMAN, MARY C
PO BOX 7068				
PASADENA, CA 91109-7068			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/799,143	BIEDERMANN ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
Mary Hoffman	3733		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 and 21-28 is/are pending in the application.
  - 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8, 21-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____.	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Priority*

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 3/11/2003. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b). the examiner acknowledges that the translation of this document has been received.

### *Election/Restrictions*

Applicant's election of Group I, Figs. 1 ad 2, claims 1-8 and 21 in the reply filed on 07/28/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 9-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 07/28/2006. Claims 16-20 have been cancelled in the amendment to the claims, filed 7/20/2006.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-8, 21-25 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb (U.S. Patent No. 4,763,644) in view of Jackson et al. (6,224,596).

Webb discloses an anchoring element for use in spinal or bone surgery (FIG. 2); the anchoring element comprising a shaft (ref. # 5); a rod (ref. #4) having a pre-determined diameter (D) and an outer surface; a receiving part (ref. #9), which is connected to the shaft and is structured and arranged to connect to a rod receiving part having a longitudinal axis and comprising a U-shaped recess forming a channel (ref. #11) and two legs having free ends, the legs comprising an external threading (ref. #15) and receiving a screw nut (ref. #7) with an internal threading (ref. #14), the legs further providing an exterior end surface (top, exterior surface of the legs) of the receiving part; and a securing element (ref. #6) that engages and cooperates with the interior surface; whereby a first distance from the exterior end surface of the receiving part to a closest portion of the outer surface of the rod in an axial direction is a pre-determined distance (A); the first thread extending from the exterior end surface of the receiving part to a second distance that is smaller than or equal to the pre-determined distance (A); and the receiving part further comprising an undercut (outer curved surface below threading ref. #15) and the first thread extending to the undercut, the undercut having an edge farthest away from the first thread, the edge being located at a third distance (B) from the exterior end surface, the distance (B) being larger than the predetermined

distance (A). The depth of the undercut corresponds to the depth of ref. #6. The shaft and receiving part are monoaxial and integral.

Webb discloses the claimed invention except for a securing element (ref. #6) comprising a second thread that engages and cooperates with a first thread.

Jackson discloses an improved set screw system (i.e. securing element) comprising a second thread that engages and cooperates with a first thread that allows the threaded securing element to secure a rod in a relative position and then facilitates subsequent removal of the securing element from the threaded bore (col. 3, lines 26-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the device of Webb et al. with the securing element comprising a second thread that engages and cooperates with a first thread in view of Jackson in order to secure a rod in a relative position and then facilitate subsequent removal of the securing element from the threaded bore.

Claims 6 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb (U.S. Patent No. 4,763,644) in view of Jackson et al. (6,224,596)further in view of Hall (U.S. Patent No. 4,041,939).

Webb in view of Jackson disclose the claimed invention except for the first and second threads each are a thread selected from a metric thread, a buttress thread, a flat thread or a thread with a negative load-beating angle.

Hall discloses of using anchoring elements with buttress threads, which allows the element to be firmly secured to the vertebrae (col. 1, lines 51-60).

It would have been obvious to one skill in the art at the time of the invention was made to make an device of Webb in view of Jackson with buttress threads in view of Hall in order to have a firmly secured anchor element.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER